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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,923	04/26/2000	John Albert Kembel	10351-0006	1656

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EXAMINER

NGUYEN, CHAU T

ART UNIT PAPER NUMBER

2176

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Best Available Copy

Office Action Summary

Application No.

09/558,923

Applicant(s)

KEMBEL ET AL

Examiner

Chau Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/19/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

2)

DETAILED ACTION

1. Amendment, received on 04/19/2005, has been entered. Claims 39-50 are presented for examination.

Information Disclosure Statement

2. The information disclosure statement filed 04/19/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. WO 01/80086A2 has been placed in the application file, but the information referred to therein has not been considered.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 39-50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32-47 of copending Application No. 09/558,922. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is similar to the context of the cited claims of the Application No. 09/558/922.

Application No. 09/558,922 discloses a method of providing Internet content to a user of a computing device including receiving a request from a computing device, in response to the request, retrieving information usable by the computing device to present data that is programmed in a format readable by a Web browser program outside of a window of a Web browser program, wherein the data comprises content data and a definition that defines at least in part a functionality and an appearance of a

user interface with which the content data is presented, and transmitting the information to the computing device. Since Application No. 09/558,922 discloses receiving a request from a computing device, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take an action to incorporate a display menu of user selectable items in the request so the user can select/request items of interests and server can locate and send interested items to the user.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 39-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan, and further in view of Huang et al. (Huang), US Patent Application Publication No. US 2002/0091697.

7. As to claims 39 and 45, Dasan discloses a method of co-ordinating delivery of Internet content to a user of computing device, comprising:

displaying a menu of user selectable items (col. 6, lines 20-52 and Fig. 6: a display screen 600 displaying selectable items such as Lookup New Profile item, Generate News item, or doit item); and

in response to selection of one of the user selectable items, displaying information through a user interface (col. 7, line 42 – col. 8, line 40: generating a personal newspaper based on the selections of Sun News, Microsoft News, and Generate News item).

However, Dasan does not explicitly disclose displaying information outside of a window of a Web browser program through a user interface of which functionality and appearance is defined at least in part by data that is programmed in a format readable by a Web browser program. In the same field of endeavor, Huang discloses a browser display including a list of selectable items such as icons for applications, icons for folders and files, icon for news and information, icon for browser bookmarks, etc. (page 4, paragraph [0047] and Fig. 3). Huang also discloses user clicks on icon for news and information, then a list of available URL links to other web sites is displayed on a window 436 (this window is outside of the web browser), each link is associated with the URL of another web page on the web, and the URL links appear to the user as text that is highlighted such that by selecting the link with the mouse, the user can move to a

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web page corresponding to the selected link (pages 4-5, paragraphs [0051]-[0054]). Since Huang discloses a virtual desktop in a computer network for retrieving personal web site for user from a file server, which is similar to a method for retrieving information based on a personalized newspaper of Dasan, thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Huang and Dasan to include displaying information outside of a window of a Web browser program through a user interface of which functionality and appearance is defined at least in part by data that is programmed in a format readable by a Web browser program. Through the personal web page, the user is not only able to send commands that are received and processed by one or more backend servers, but also able to access the servers from a variety of systems through different communications links available to connect to the Internet.

8. As to claims 40 and 46, Dasan and Huang disclose in response to selection of a second one of the user selectable items, displaying second information outside of a window of a Web browser program through a second user interface of which functionality and appearance is defined at least in part by second data that is programmed in a format readable by a Web browser program (Huang discloses a browser display including a list of selectable items such as icons for applications, icons for folders and files, icon for news and information, icon for browser bookmarks, etc. (page 4, paragraph [0047] and Fig. 3). Huang also discloses user clicks on icon for news and information, then a list of available URL links to other web sites is displayed

on a window 436 (this window is outside of the web browser), each link is associated with the URL of another web page on the web, and the URL links appear to the user as text that is highlighted such that by selecting the link with the mouse, the user can move to a web page corresponding to the selected link (pages 4-5, paragraphs [0051]-[0054]). Since Huang discloses a virtual desktop in a computer network for retrieving personal web site for user from a file server, which is similar to a method for retrieving information based on a personalized newspaper of Dasan, thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Huang and Dasan to include displaying information outside of a window of a Web browser program through a user interface of which functionality and appearance is defined at least in part by data that is programmed in a format readable by a Web browser program. Through the personal web page, the user is not only able to send commands that are received and processed by one or more backend servers, but also able to access the servers from a variety of systems through different communications links available to connect to the Internet.)

9. As to claims 41 and 47, Dasan and Huang disclose in response to selection of one of the user selectable items, retrieving the information to be displayed from a computer memory (Dasan, col. 4, line 8 – col. 5, line 7).

10. As to claims 42 and 48, Dasan and Huang disclose in response to selection of the selectable item, retrieving the data that defines at least in part the user interface

from the computer memory (Dasan, col. 4, line 51 – col. 5, line 7 and col. 5, line 53 – col. 6, line 52).

11. As to claims 43 and 49, Dasan and Huang disclose in response to selection of one of the user selectable items, retrieving the information to be displayed from a URL address (Dasan, col. 7, line 42 – col. 8, line 40).

12. As to claims 44 and 50, Dasan and Huang disclose in response to selection of the selectable item, retrieving the data that defines at least in part the user interface from a second URL address (Huang discloses a browser display including a list of selectable items such as icons for applications, icons for folders and files, icon for news and information, icon for browser bookmarks, etc. (page 4, paragraph [0047] and Fig. 3). Huang also discloses user clicks on icon for applications (second link or URL address), then a list of available applications is displayed on a window 432 (this window is outside of the web browser) (pages 4-5, paragraphs [0051]-[0054]). Since Huang discloses a virtual desktop in a computer network for retrieving personal web site for user from a file server, which is similar to a method for retrieving information based on a personalized newspaper of Dasan, thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Huang and Dasan to include displaying information outside of a window of a Web browser program through a user interface of which functionality and appearance is defined at least in part by data that is programmed in a format readable by a Web browser

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program. Through the personal web page, the user is not only able to send commands that are received and processed by one or more backend servers, but also able to access the servers from a variety of systems through different communications links available to connect to the Internet.).

Response to Arguments

13. Applicant's arguments and amendments, filed on 04/19/2005, have been fully considered but they are not deemed fully persuasive. Applicant's arguments with respect to claims 39-50 have been considered but are moot in view of the new ground(s) of rejection as explained above, necessitated by Applicant's substantial amendment (i.e., displaying information outside of a window of a Web browser program through a user interface of which functionality and appearance is defined at least in part by data that is programmed in a format readable by a Web browser program) to the claims which significantly affected the scope thereof.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The examiner can normally be reached on 8:30 am – 5:30 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen
Patent Examiner
Art Unit 2176

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
7/5/2005

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